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| 10/033,518 | 12/28/2001 | Robert B. Hope | ULB-003CV | 8646 |
| 7590 Kenneth J. LuKacher, Esq. South Winton Court Suite 204 3136 Winton Road Rochester, NY 14623 | | 08/31/2010 | EXAMINER REDMAN, JERRY E | |
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT B. HOPE

Appeal 2009-006381
Application 10/033,518
Technology Center 3600

Before: WILLIAM F. PATE III, MICHAEL W. O'NEILL, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1-10. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

The claims are directed to a weather seal. Claims 1 and 5, reproduced below, are illustrative of the claimed subject matter:

1. A weather seal comprising a core, a substrate of recycled elastomeric material encapsulating said core, a covering of virgin elastomeric material providing a sealing surface and encapsulating said core and substrate.

5. A weather seal comprising a core, longitudinal extension control and reinforcing elements applied along only one side of said core by carrying said core around a wheel which exposes a space thereof, applying said element through said space as said wheel rotates, and attaching said elements to said core in said space after application.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| | | |
|-------|----------------|---------------|
| Keys | US 5,221,564 | Jun. 22, 1993 |
| Vinay | US 5,416,961 | May 23, 1995 |
| Iwasa | JP 08 012815 A | Jan. 16, 1996 |

REJECTIONS

Claims 5-7, 9 and 10 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Ans. 3.

Claims 1, 3-5, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Keys and Iwasa. Ans. 3.

Claims 2, 6, 7, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Keys, Iwasa, and Vinay. Ans. 4.

OPINION

Regarding the Examiner's rejection of claims 5-7, 9 and 10 under 35 U.S.C. § 112, second paragraph as being indefinite, the Examiner's argument that it is not apparent whether claim 5 is directed to an apparatus or process is not persuasive. Claim 5 is clearly directed to a weather seal—an article of manufacture. There is nothing wrong with defining an article by the process by which it is made, i.e., as a product-by-process claim. The patentability of such claims depends upon the product and not its method of production. *In re Thorpe*, 777 F.2d 695, 698 (Fed. Cir. 1985) (citations omitted). Accordingly, we reverse the Examiner's rejection of claims 5-7, 9 and 10 under 35 U.S.C. § 112, second paragraph.

Regarding the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Keys and Iwasa, we agree with Appellant that the Examiner's interpretation of "encapsulating" is unreasonable. App. Br. 5; Reply Br. 2. Keys second layer 21, read as the claimed "covering," does not "encapsulate[]" the first layer 17, read as the claimed "substrate," by virtue of the tongue-and-groove-type joint 28. *See, e.g.*, Keys, col. 2, l. 57-col. 3, l. 9. Though no explicit definition is provided, consistent with the Specification and the ordinary meaning of the term "encapsulate," we construe claim 1 to require a covering that encases substantially all of the core and substrate. *See, e.g.*, Spec. Fig. 2. Keys' second layer only partially surrounds a small portion of the first layer and

therefore does not encapsulate it. *See* Keys, Fig. 2. Neither Iwasa nor Vinay, as applied by the Examiner, cures this deficiency. Accordingly, the rejection of independent claim 1, and the rejections of its dependent claims 2-4 and 8, under 35 U.S.C. § 103(a) cannot be sustained.

The weather seal recited in independent claim 5, although grouped with claim 1 in the Answer, requires a significantly different structure than that of claim 1. The claim requires a seal having longitudinal extension control and reinforcing element applied along only one side of a core. App. Br. 6. The Examiner does not discuss how the seal produced by this process, which must have a reinforcing element on only one side of a core, is rendered obvious by the combination of Keys and Iwasa. Neither reference discusses reinforcing elements of a core. Since all words in a claim must be considered in judging obviousness, the Examiner has failed to make a prima facie case. Vinay, as applied by the Examiner, does not cure this deficiency. Accordingly, the rejection of independent claim 5, and the rejection of its dependent claims 6, 7, 9 and 10, under 35 U.S.C. § 103(a) cannot be sustained.

DECISION

For the above reasons, the Examiner's rejections of claims 1-10 are reversed.

REVERSED

nlk

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